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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,370	10/16/2001	Scott Carl Smith	A-7600	3961

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EXAMINER

ALLEN, ANDRE J

ART UNIT

PAPER NUMBER

2855

DATE MAILED: 08/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/977,370	SMITH, SCOTT CARL	
	Examiner	Art Unit	
	Andre J. Allen	2855	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on amndt filed 5-27-03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. **Acknowledgment is made of the amendment filed 5-27-03**

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,2,6,7,10,11 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al.

In claims 1, and 10 securing a sample/measurement surface 7 to the top end of a column 9,10 lowering a stylus/punch 21 to contact the sample and recording a vertical height (claim 1) of the stylus/punch; Moving the stylus/punch downward until the sample ruptures (claim 1), measuring the distance traveled by the stylus from the starting point and the rupture point (claim 1,2), and measuring the force applied by the force applied by the stylus at rupture. (claim 1)

In claims 1 and 10 Kim et al does not explicitly teach contacting the sample until movement of the stylus is not possible without movement of the sample. However in figure 5 the punch 21 is clearly showing contact of the

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sample until movement of the stylus is not possible without movement of the sample therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use this function since Kim et al is clearly lowering a punch into a sample and penetrating said sample.

In claims 2 and 11 Kim et al does not disclose lowering the punch at a constant speed. However Kim et al teaches a material tester that includes moving a punch 21 to engage a test specimen 7 to apply a stretch force (claim 1) this teaching would clearly suggest a constant speed. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify a material testing apparatus to be lowered at a constant speed for the purpose of effectively testing the strength of material as taught by Kim.

In claims 3,9 and 12 with respect to a constant speed being 508.0 mm/min and the diameter of the stylus being 7mm and diameter of the column being 33mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use this speed and dimensions since the cited prior art at least teaches a column and stylus, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Bosch, 617 f.2d 272, 205 USPQ 215. In this particular case, one having ordinary skill in the art could

determine the most effective dimensions for the size of a stylus through undo experimentation.

In claims 4,5,13 and 14 the sample is a glove finger, palm or cuff, however it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use a glove finger, thin film or metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. In re Ileshin 125 USPQ 416, In this particular case any material with respect to a thin film, a sheet or whatever material suitable for a particular specimen material test could be used.

In claims 6,15 Kim et al shows a sample 7 having a uniform thickness film {fig. 5}.

In claim 7 Kim et al does not teach calculating the rupture strength of the sample by using the formula $(05) \text{ Stylus Travel Distance Stylus Force} / \text{Sample at Rupture at Rupture TI}$. However, since Kim et al is teaching testing the strength of a material it would have been clearly obvious to a person having ordinary skill in the art at the time the invention was made to modify a test to include an equation for the purpose of calculating material strength from parameters measured during test periods.

In claims 16 and 17 Kim teaches a stylus that is longer than the column fig.

3.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al in view of in view of Tsui et al.

In claim 8 Kim et al does not teach forming an aperture in the bottom of said column for vacuum protecting however, Tsui teaches a material tester that lowers an indenter 4 and penetrates a sample 20 {col. 7 lines 20-25}and includes forming an aperture in the bottom of said column for vacuum protecting {col. 10 lines 1-5}. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to form a vacuum for the purpose of sealing an area through a passage as taught by Tsui et al.

Allowable Subject Matter

4. Claims 18 and 19 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The cited prior art does not disclose nor suggest securing the

sample to the top end of the column and extending the edge of the sample along the outside surface of the column.

Response to Arguments

5. Applicant's arguments filed 5-27-03 have been fully considered but they are not persuasive.

In response to the applicant's argument that the cited prior art does not disclose a lowered stylus but a raised stylus, examiner admits that the Kim reference raises a stylus, however Tsui et al clearly lowers a stylus like element into a material moreover, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to either raise or lower a stylus simply for the purpose of contacting a sample clearly would be within the general skill of a worker.

In response to the applicant's argument that the cited prior art does not teach a column, the examiner asserts that the positioning of the clamps at a side by side positioning in figure 5 of Kim would clearly suggest a column. In response to the applicants arguments that the cited prior art does not teach an aperture in the bottom of a column is clearly disclosed by Tsui et al.

In response to applicant's argument that Tsui et al and Kim et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the cited prior art is testing samples of a particular material by contacting a material and penetrating, fracturing the said material.\

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a stylus lowered into a cylinder) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the

THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre J. Allen whose telephone number is 703-3081989. The examiner can normally be reached on mon-fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Lefkowitz can be reached on 703-305-4816. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3432 for regular communications and 703-308-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

A.J.A
August 7, 2003


EDWARD LEFKOWITZ
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